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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/659, 046      06/03/96      BAUER

P      07807/006001

QM12/0930

EXAMINER

JOHN B. PEGRAM  
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DEXTER, C

ART UNIT	PAPER NUMBER
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3724

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DATE MAILED: 09/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

08/659,046

Applicant(s)

Bauer et al.

Examiner

Clark F. Dexter

Group Art Unit

3724

 Responsive to communication(s) filed on Aug 9, 1999. This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims** Claim(s) 13, 14, and 17 is/are pending in the application.Of the above, claim(s) 13 and 14 is/are withdrawn from consideration. Claim(s) \_\_\_\_\_ is/are allowed. Claim(s) 17 is/are rejected. Claim(s) \_\_\_\_\_ is/are objected to. Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers** See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner. The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119** Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All  Some\*  None of the CERTIFIED copies of the priority documents have been received. received in Application No. (Series Code/Serial Number) 08/508,255. received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)** Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152**-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --**

Art Unit: 3724

## **DETAILED ACTION**

### *Continued Prosecution Application*

1. The request filed on August 9, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/659,046 is acceptable and a CPA has been established. An action on the CPA follows.
2. The preliminary amendment filed August 9, 1999 has been entered.

### *Claim Rejections - 35 USC § 112*

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 1, the characterization of the claimed invention as “[A] hand tool” renders the claimed subject matter vague and indefinite, particularly since it is not clear how the disclosed components (e.g., the shearing element (i.e., disc) 1a along with its handle 11, and the shearing element (i.e., disc) 2a along with its handle 11) comprise a single hand tool when they appear to be separate tools that are being used together to perform a particular function; in lines 5-6, “cutting edges in the form of a fixed slot” is vague and indefinite and appears to be inaccurate since the fixed slot is not the cutting edge but rather forms the cutting edges, and it is suggested in lines 5-6 to change “in the form of” to --at its lower side, said upper disc cutting edge formed by--

Art Unit: 3724

, and in line 6 to delete "at its lower side" and insert a comma --,-- after "fixed slot"; similarly, in line 7, "cutting edges in the form of a fixed slot" is vague and indefinite and appears to be inaccurate; in line 8, "said sides" is vague and indefinite as to which sides of each disc.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3724

6. Claim 17 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelosi, Jr. et al.

Pelosi, Jr. et al. discloses a hand tool with every structural limitation of the claimed invention including a disc (e.g., 12) having opposing cutting edges in the form of a fixed slot (e.g., 18) which slot narrows toward the center of the disc, and having a handle (e.g., 16).

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Pelosi, Jr.'s tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Art Unit: 3724

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfd  
September 29, 1999